

REMARKS

Claims 1, 2, 5-9, 11-12, 14, 16-17, 19, 21, 23, 24, and 26-28 are pending in the application. Claims 1, 11, and 19 have been amended, leaving claims 1-2, 5-9, 11-12, 14, 16-17, 19, 21, 23-24, and 26-28 for consideration upon entry of the present Amendment. Support for the amendment can be found on page 14, lines 16 to 25. As will be discussed in detail below, it is believed that the application is in condition for allowance.

Claims 1-2, 5-9, 11-12, 14-17, 19, 21, and 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/30338 in view of Manico et al. (US 6,373,551) ("Manico"). For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Claims 1-2, 5-9, and 26 include the following limitations: "storing said data in a server computer connected to said network in a region set in association with a unique address or unique data assigned to the user; and * * * wherein said unique address or unique data is stored in a memory of said device." Claims 11-12, 14, 16-17, and 27 include the following limitations: "storage means connected to said network for storing said data in a region set in association with a unique address or unique data assigned to the user; and * * * wherein said unique address or unique data is stored in a memory of said device." Claims 19, 21, 23-24, and 28 include the following limitations: "means for storing data previously stored in a device returned by a user, said data stored in a region set in association with a unique address or unique data assigned to the user and stored in a memory of said device." Neither WO 00/30338 nor Manico teach or suggest those limitations.

The Examiner asserts that WO 00/30338 teaches the storing of data in a server computer connected to the network in association with a unique address or unique data assigned to the user. The Examiner points to page 32, line 8 through page 35, line 22. However, the claims as amended recite that the storage of data is in a region in association with a unique address or unique data assigned to the user. WO 00/30338 does not teach or suggest that the storage of data is in a region set in association with a user ID. Instead, WO

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00/30338 describes that the storage of data occurs in the storage module 1200 and there is no description that the storage of data is in a region set in association with a user ID. Moreover, Manico does not cure the deficiencies of WO 00/30338. Accordingly, WO 00/30338 and Manico do not teach or suggest all of the limitations of claims 1-2, 5-9, 11-12, 14, 16-17, 19, 21, and 23-24. Applicants respectfully request that the rejection be withdrawn.

Claims 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 00/30338 and Manico. The Examiner asserts that it would have been an obvious matter of design choice at the time the invention was made to modify WO 00/30338 and Manico to include that the unique address or unique data is stored in a root directory area in a memory of the device. Applicant respectfully traverses.

This type of "design choice" rejection has been criticized by the Court of Appeals for the Federal Circuit. In the case of *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1995) (citing *In re Gal*, 25 USPQ2d 1076 (Fed. Cir. 1992)), the Federal Circuit reversed a Board of Appeals rejection based on design choice and held that a "finding of 'obvious design choice' precluded where the claimed structure and the function it performs are different from the prior art." In other words, the Examiner cannot ignore the claimed structure and the function it performs. In the present case, although the memory includes a boot record area, a FAT (file allocation table) area, a root directory area, an image data area, an audio data area, and the like, the address is stored in the root directory area, which enables an effective use of the memory. In other words, user convenience is increased by storing an address or data without trading off the capacities of the image data area and the audio data area in the memory. Neither WO 00/30338 nor Manico teach or suggest such limitation and as such, the rejection is improper. Accordingly, Applicants respectfully request that the rejection be withdrawn.


In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

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In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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